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VENABLE LLP			PARKER, FREDERICK JOHN	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/630,982
Filing Date: July 31, 2003
Appellant(s): DUNMAN, JAMES

Stuart I. Smith
For Appellant

EXAMINER'S ANSWER

MAILED
MAY 10 2006
GROUP 1700

This is in response to the appeal brief filed April 21, 2006 appealing from the Office action mailed November 21, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections of the previous Office action.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17-20 include limitations that shields do not hold a threaded engagement portion of a finish of the containers for which Applicants cite figure 1 as support.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-4,6,8-12,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620.

Carl teaches a method of coating threaded glass containers, in which the threaded closure portion of the container 12 contacts a threaded masking chuck 18 of body member 10 on support means 21, which in turn is part of a conveyor means 25 . The threaded masking means is a “shield” to prevent coating of threaded portions of the container. The conveyor moves the containers to a coating area where they are coated by spray gun 22(without further limitation) or other coating means. See col. 3, 50 to col. 4, 26. Body member 10 may be fabricated from plastic materials such as HD PE, “Bakelite”, etc without limitation as to forming method. Hence it is the Examiner’s position that it would have been obvious to form such articles by known and conventional forming means, such as injection molding, because the process is conventionally used to form complex plastic polymer parts. The reference also teaches on col. 1, 47-51 that containers of plastic, ceramic, etc in addition to glass are conventionally coated by spraying or other means. However, the reference does not explicitly state the material making up the masking/ shielding means is the same as, and made from scrap of, the containers even though it

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is apparent from the reference that both containers and masking/ shielding means can be made of a polymeric plastic.

White also teaches the concept of coating certain portions of a container while shielding other portions from the coating material. Shielding means 114 are taught, without limitation of the material from which it is made. In col. 1, 13-22, it is specifically taught that the beverage industry is substituting polymeric plastics, and particularly the polyester polyethylene terephthalate (PET), for containers in place of glass or metal. It further teaches that containers must be recyclable due to state and federal mandates, and that PET material is recyclable (col. 1, 63-68; etc). The recycling of scrap material from a PET container-making operation would therefore have been an obvious variation given the teachings of White because there is simply no reason to expect that formed containers and scrap from making the same formed containers would have any difference in their ability to be recycled and reformed, absent a clear and convincing showing to the contrary. Hence it would have been obvious to substitute the glass container of Carl with an equivalent polymer plastic container to follow industry trends and comply with recycling regulations as taught by White. Carl is not limited to specific engineering polymer materials from which the masking body members are formed, and White teaches that formable/ recyclable engineering polymeric plastics such as PET are used to make threaded containers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the process of Carl et al on plastic instead of glass container to follow the industry trends disclosed by White, and further using a polymeric masking body member of recycled scrap PET from the plastic container making process because White also discloses that PET can be recycled to be re-formed into articles. Further, the use of production scrap to make

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the polymeric masking body would have provided an opportunity to re-form container scrap into a useful product used in container production, resulting in apparent economic benefits.

As to claims 11-12, it would have been obvious to the skilled artisan to perform maintenance on the conveyor/ production line at an interval commensurate with the use of the production line to remove and dispose of broken or mal-functioning parts, including the masking/ shielding means.

2. Claims 5,7,13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620 and further in view of the Admitted Prior Art (APA).

Carl et al and White are cited for the same reasons previously discussed, which are incorporated herein. Oxygen barrier coatings are not disclosed. However the APA discloses it is known to electrostatically apply oxygen barrier coats to plastic polymer/ PET containers, except at threaded portions, to prevent the adverse effects of oxygen migration through the walls of the containers. Since electrostatic coating encompasses electrostatic spraying, and Carl et al teaches to apply coatings to containers by “spraying”, the use of electrostatic spraying would have been an obvious variation of the teachings of Carl et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Carl et al in view of White by electrostatically spraying oxygen barrier coatings to container surfaces to prevent the adverse effects of oxygen migration through the walls of the containers.

(10) Response to Argument

Claim Rejections - 35 USC § 112/ 1st Paragraph, New Matter

Applicants cite figure 1 as support, and argue “shield 10 does not engage or hold the threaded engagement portion of the container 18”.

The Examiner provides an exploded view of figure 1 as attached and notes that the lower section of the upper shield (referred to by the arrow) contacts and interlocks (i.e. “engages”) AND imposes “restraint upon or limit(s) in motion or action” (“hold”, per the dictionary meaning of the term on the record) on the container 18 by virtue of the overlapping contact of the shield shoulder and the top portion of the threaded portion of container 18. The Examiner does not argue that a figure may provide support for claim language; however, the issue at hand here is that the figure cited by Applicants does NOT SUPPORT the claim language as reasonably interpreted by the Examiner.

Since Applicants’ sole support is figure 1 and the specification fails to supply further meaning of the limitation, the Examiner maintains the New Matter rejection of claims 17-20.

Claim Rejections - 35 USC § 103

Claims 1-4,6,8-12,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620.

Applicants argue there is “no suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art” to combine the references. The Examiner respectfully disagrees. Recycling of waste or consumer-used plastics is

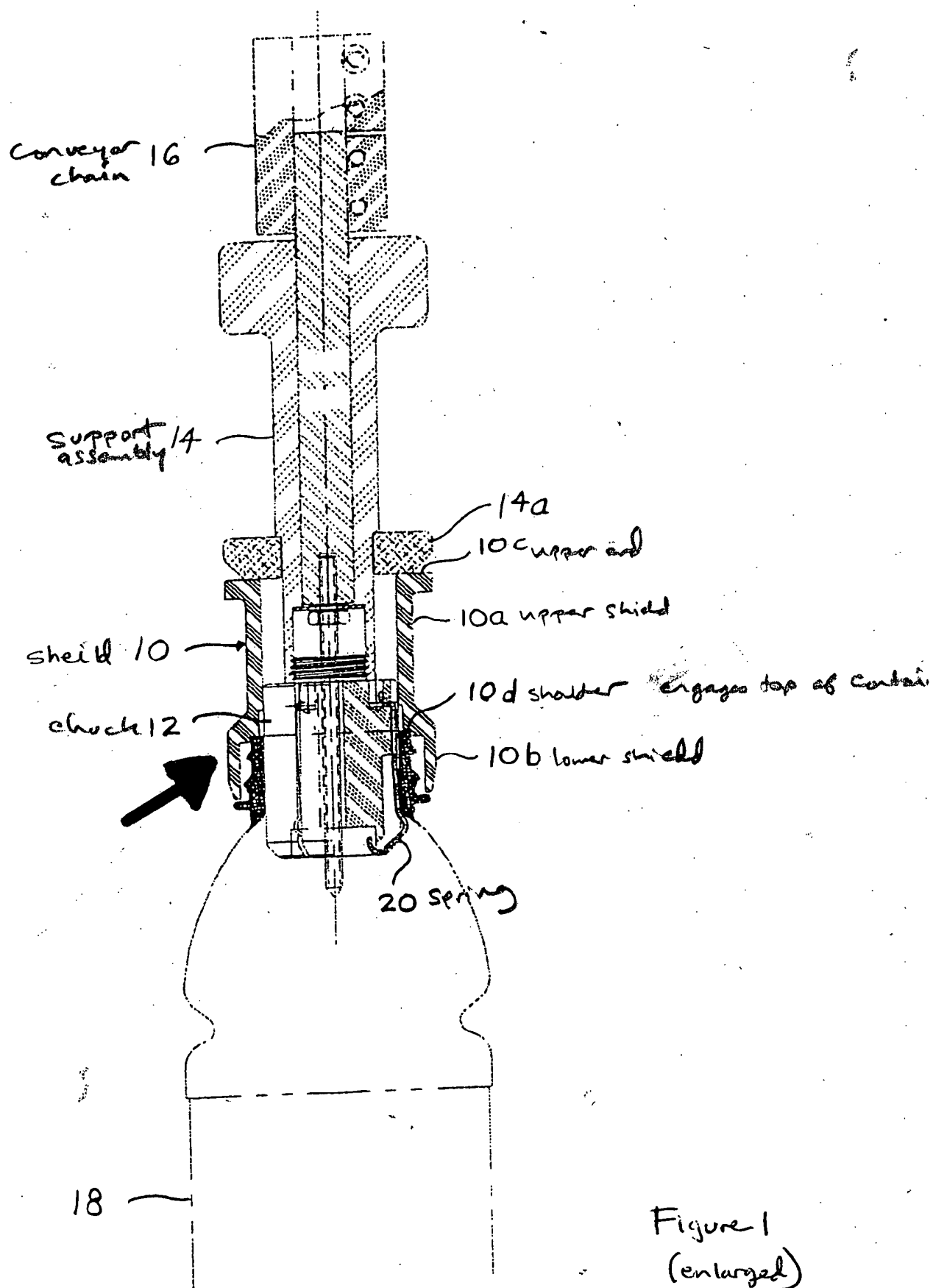


Figure 1
(enlarged)

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pervasive in our culture to reduce landfill waste and enhance cost-effectiveness of our plastic resources. This is known and apparent to at least those of ordinary skill. The reader is reminded that the criteria of *Graham v. Deere* includes “Resolving the level of ordinary skill in the pertinent art” which the Examiner has done with considerable thought in the rejection. Furthermore, Applicants appear to have ignored White col. 1, 63 to col. 2, 2 and col. 4, 13-15 which recognizes the trend towards recycling as far back as 1987. It is the Examiner’s position that recycled plastic ware or scrap/ waste from the process of making said plastic-ware are identical in properties and composition, and therefore equally recyclable, absent a clear and convincing showing of unexpected or synergistic results to the contrary. Applicants have provided no such results/ evidence by which the Examiner can determine that Applicants’ process defines a clearly patentable demarcation over the prior art. To further support the point, the Examiner cites US 5712009 to illustrate the state of the art, wherein col. 5, 28-29 equates “post consumer recycled...resin, process trim, and off ware scrap” (recycling is also discussed in col. 1, 11-60). Applicants simply fail to convincingly set forth why a recycle article made from process waste scrap would be different from one made from post consumer or other plastic recycle so well known in manufacturing. Applicants’ argument that the Examiner acknowledges Carl does not make the shield/ member from container scraps is unclear since this is a 35 USC 103 rejection in which the Examiner is bound to point out what is missing from the primary reference prior to introducing the secondary reference. Thus the argument set forth by Applicants is not persuasive and the motivation to combine is clearly set forth.

As to the second argument that the combination of references fails to teach all the claim limitations, the above explanations are equally relevant and incorporated herein for brevity. A

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part made from scrap of a material from a process would reasonably be expected to provide equivalent outcomes as recycled products made from the material from which the scraps originated. Thus, Applicants second argument is not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The above explanations and rejections are equally relevant and incorporated herein for brevity. The reader of ordinary skill would not be convinced by the hindsight argument given the teachings of the references and the way the prior art has been crafted to provide a logical rejection. The Applicants have also failed to provide any reasoning or evidence why manufacturing using scrap from the container-making process would have provided a different recycled plastic product with unexpected/ patentable results than compositionally similar recycle of manufactured post-consumer products.

Claim 15

The rejections and rebuttals regarding the obviousness of the process are incorporated herein for brevity. As to claim 15, the limitation is present that "the shields are removably held on the conveyor by a friction fit". The means of the prior art holds the articles on the chucks by

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“friction fit” given the meaning of Applicants as read in view of the spec. page 3, 1-2. Thus, the prior art meets the limitation as broadly interpreted by the Examiner.

Claim 16

The rejections and rebuttals regarding the obviousness of the process are incorporated herein for brevity. It is the Examiner’s position that the shields of Carl are not permanent/ never to be removed for maintenance or cleaning during shutdown in order to give the process utility. It is unreasonable to expect that a completed, faulty or unusable part on a conveyor process is left, and would ultimately cause disablement of the process as well as defeat the apparent reason for the process of Carl. Clearly process line maintenance and removal of unusable or broken parts or completed parts is well within the level of ordinary skill.

Claims 5,7,13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620 and further in view of the Admitted Prior Art (APA).

The rejections and rebuttals regarding the obviousness of the process are incorporated herein for brevity. Applicants supply no additional arguments for this section.

Claim 13

Applicants note claim 13 is similar to claim 1 and appeals claim 13 for the same reasons as those for claim 1.

In response, the Examiner cites the rejections and rebuttals regarding the obviousness of the process above, which are incorporated herein for brevity.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Fred J. Parker



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